UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,274	11/25/2003	Peter J. Ford	884A.0025.U1(US)	2959

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EXAMINER
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ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/725,274	FORD ET AL.
	Examiner	Art Unit	
	ERIC ELCENKO	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2009*.
2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.
   4a) Of the above claim(s) *7 and 15* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-6,8-14 and 16-35* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

1.   Applicant's arguments with respect to claims 1-6, 8-14, 16-19 and 33-34 have

been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 20-32 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

4.   The applicant has amended to independent claims 20 and 28 to include a

limitation read as: "a user selectable option to set up a new channel that runs in parallel

with a voice channel used for the telephone call." The included specification details a

user selectable option to send data while on an in-progress telephone call. The

specification goes on further to describe a new channel will be setup if the user is on a

telephone call to send the data. There is no disclosure, mention or suggestion of a user

being able to set up a new parallel channel. Disclosing a choice to send data and then

describing later how it will be sent does not constitute a user selecting to setup a

parallel channel to the voice communication.   There is no reason for one of ordinary

skill in the art at the time of the invention to interpret the disclosure in the way as

amended by the applicant of a user selectable option, the option being the setup of a

new channel in parallel. Appropriate correction is required to remove or amend the

current claimset to include subject matter supported by the specification.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-6, 8-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lin et al. (U.S. Pub. No. 2005/0096071) in view of Lielbriedis (U.S.

Pub. No. 2001/0051528) in view of Paik et al. (U.S. Pub. No. 2008/0153471

In regard to Claim 1, Lin et al. discloses a method of sending data from a first

party participating in a telephone call to a second party in the telephone call *(Lin*

teaches a system and method for communicating data over a voice channel on a

wireless device. The method includes establishing an audio connection with a second

device providing an interface for a user for sending data to the second device (Abs))

Lin does not directly disclose storing an identifier and using the stored identifier

to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile

communication station in the originating address data space of a short message. At a

later stage when the mobile responds to the message, the received originating address

will constitute the destination address and the identifying information will be returned

from the mobile station in the destination address data space of the response. Lin

teaches the transfer of data between the two stations and it can obviously be seen that

the address of the two mobiles is being used in the exchange as destination addresses

for the communication. Lielbriedis is used to show specifically that information in data

communication is sent automatically in a response to the originating terminal which sent

the data.

It would have been obvious to one of ordinary skill in the art to modify Lin to

include the teachings of Lielbriedis in order to directly respond to the communicating

terminal using the original communication identification information as a destination

address.

The combination does not directly disclose wherein using the stored identifier to

determine automatically the destination address comprises interrogating a database

using the stored identifier data to obtain the destination address.

Paik teaches a caller identifier detecting unit which detects an identifier of an

originating mobile terminal, a control unit which controls storage of the caller identifier

information, and a caller identification generating unit. The identifier managing unit 45

manages the identifier of the respective mobile termina in the form of a database under

the control of the control unit. (Para 45-47)

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combination to include the teaching of Paik. One of ordinary skill

in the art could have combined the known prior art elements using known techniques to

yield predictable results to one of ordinary skill in the art of a database logging the caller

identifiers for a communication.

In regard to Claims 2-6, it is obvious to one of ordinary skill in the art that a

identifier information that would be stored would be of the setup communication

between the two terminals, including the telephone number, a CLI or equivalent.

In regard to Claim 8, Lielbriedis teaches storing the identifying information and

being able to later retrieve the information for a response to the messages. (Para 9)

In regard to Claims 9 and 17, Lielbriedis discloses the destination address is any

one of: an email address, a telephone number, a Bluetooth device address. (Para9, *it is

also evident the connection is made in Lin by use of a telephone number between the

devices*)

In regard to Claims 10-11, 18-19, Lin discloses providing, only during the

telephone call a user selectable option to transfer data to the other party participating in

the telephone call without user specification of a destination address. (*Lin teaches three

options, one of which is sending data to the other party by selecting the option of

pushing that particular button. The address of the participating party is not specified as

the connection is already made and the address is known. (Para 35 – 39)*

In regard to Claim 12, Lin et al. discloses a method of sending data from a first

party participating in a telephone call to a second party in the telephone call *(Lin

teaches a system and method for communicating data over a voice channel on a

wireless device. The method includes establishing an audio connection with a second

device providing an interface for a user for sending data to the second device (Abs))*

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

The combination does not directly disclose wherein using the stored identifier to determine automatically the destination address comprises interrogating a database using the stored identifier data to obtain the destination address.

Paik teaches a caller identifier detecting unit which detects an identifier of an originating mobile terminal, a control unit which controls storage of the caller identifier information, and a caller identification generating unit. The identifier managing unit 45 manages the identifier of the respective mobile termina in the form of a database under the control of the control unit. (Para 45-47)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination to include the teaching of Paik. One of ordinary skill

in the art could have combined the known prior art elements using known techniques to yield predictable results to one of ordinary skill in the art of a database logging the caller identifiers for a communication.

In regard to Claims 13 and 14, it is obvious to one of ordinary skill in the art that a identifier information that would be stored would be of the setup communication between the two terminals, including the telephone number received via the radio cellular transceiver, i.e., the call.

In regard to Claim 16, it would be obvious to one of ordinary skill in the art that each message stored from Lielbriedis and its associated identifying information would be connected to a different contact address as each is given a response to its respected received message.

7.   Claims 33 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over over Lin et al. (U.S. Pub. No. 2005/0096071) in view of Lielbriedis (U.S. Pub. No. 2001/0051528) in further view of Paik et al. (U.S. Pub. No. 2008/0153471)

In regard to Claims 33 and 34, Lin et al. discloses a method of sending data from a first party participating in a telephone call to a second party in the telephone call *(Lin teaches a system and method for communicating data over a voice channel on a wireless device. The method includes establishing an audio connection with a second device providing an interface for a user for sending data to the second device (Abs))*

Lin does not directly disclose storing an identifier and using the stored identifier to automatically determine a destination address for a data message. (Para 9)

Lielbriedis teaches identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile responds to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response. Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication. Lielbriedis is used to show specifically that information in data communication is sent automatically in a response to the originating terminal which sent the data.

The combination does not directly disclose wherein using the stored identifier to determine automatically the destination address comprises interrogating a database using the stored identifier data to obtain the destination address.

Paik teaches a caller identifier detecting unit which detects an identifier of an originating mobile terminal, a control unit which controls storage of the caller identifier information, and a caller identification generating unit. The identifier managing unit 45 manages the identifier of the respective mobile termina in the form of a database under the control of the control unit. (Para 45-47)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination to include the teaching of Paik. One of ordinary skill

in the art could have combined the known prior art elements using known techniques to yield predictable results to one of ordinary skill in the art of a database logging the caller identifiers for a communication.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC ELCENKO whose telephone number is (571)272-8066. The examiner can normally be reached on M-F   7:30 AM through 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Elcenko/

/NICK CORSARO/
Supervisory Patent Examiner, Art Unit 2617